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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,679	04/08/2004	Barric Tan	BT-002	1383

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EXAMINER	
MELLER, MICHAEL V	
ART UNIT	**PAPER NUMBER**
1655	

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/821,679	TAN, BARRIE	
	Examiner	Art Unit	
	Michael V. Meller	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-7,10-30,32-34 and 38-41* is/are pending in the application.

4a) Of the above claim(s) *10-14,16-29,38 and 39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-7, 15, 30, 32-34, 40, 41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

As applicant notes, claims 10-14, 16-29, 38 and 39 (method claims) are withdrawn from further consideration by the examiner as being drawn to non-elected inventions.

It is noted that applicant elected claims 5-9, 15, 30-37, 40, 41 (product claims) without traverse.

The requirement is still deemed to be proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-7, 15, 30, 32-34, 40, 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the instant specification for "essentially free of tocotrienols". Nothing in the specification supports this phrase. In fact, everything in the specification, supports just the opposite, that there are indeed tocotrienols in the composition. Applicant never identified where in the specification the alleged support could be found. Thus, "essentially free of tocotrienols" finds no support from the instant specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-7, 30, 32-34, 40, 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Alaux et al. (col. 8, lines 55-end), Levy et al. (abstract, paragraphs, 2, 7, ex. 3), Kapadia et al. (col. 7, lines 55-65) or JP 2001114628 (abstract).

Alaux, Levy and Kapadia each teach an annatto extract. Levy teaches that annatto extracts are obtained from the seeds of *Bixa orellana*. JP teaches an oral agent containing an agent from *Bixa orellana*, thus it also teaches an annatto extract. They all teach oral extracts. Since Alaux teaches an annatto extract then according to Levy, it also comes from *Bixa orellana* seeds. The composition is "essentially free of tocotrienols" since "essentially" still reads on "some" and as taught by Levy, tocotrienols are minor plant constituents. Thus, reading on "essentially free". It is inherent to the composition that geranyl geraniols are in the annatto extract as noted by applicants in their own specification, see page 11. The specifically claimed geranyl geraniols are inherently in the annatto compositions since the geranyl geraniols are derived from the annatto extract. The different isomer forms and amounts of geranyl geraniols are inherent to the annatto extract (*Bixa orellana*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-7, 15, 30, 32-34, 40, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alaux et al. (col. 8, lines 55-end), Levy et al. (ex. 3), Kapadia et al. (col. 7, lines 55-65), or JP 2001114628 (abstract) taken with JP 62123113 (abstract), GB 2178662 (page 2, lines 10-15) or WO 89/01740 (claims).

Alaux et al. (col. 8, lines 55-end), Levy et al. (ex. 3), Kapadia et al. (col. 7, lines 55-65) and JP 2001114628 (abstract) each teach what is above.

They do not teach the addition of CO-Q 10 to the composition.

JP 62123113 (abstract), GB 2178662 (page 2, lines 10-15) and WO 89/01740 (claims) all teach that CO Q-10 is known to be used in oral compositions.

It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Sussman,* 1943 C.D. 518; *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

> The reason or motivation to modify a reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. While there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.
>
> MPEP 2144 Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103. <http://www.uspto.gov/web/offices/pac/mpep/documents/2100_2144.htm>

It would have been obvious to one of ordinary skill in the art to use the annatto extract and the CO Q-10 together since they are both known individually in the art to be used in oral compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael V. Meller
Primary Examiner
Art Unit 1655

MVM